

REMARKS

Claims 1-6, 9-13, 15-22, and 24-30 are pending. Claims 29 and 30 have been canceled. Claims 1 and 24 have been amended. Claims 32 and 33 have been added. In view of the amendments and the following remarks, applicant respectfully requests reconsideration and allowance of Claims 1-6, 9-13, 15-22, 24-28, 32, and 33.

Advisory Action

Applicant acknowledges with appreciation the Examiner's comments and suggestions made in the Advisory Action mailed December 16, 2003. Applicant has amended Claims 1 and 24 to recite that the debonding agent is present in an amount from about 21 to about 50% by weight based on the total weight of the composition.

Applicant has also added Claims 32 and 33, which correspond to Claims 1 and 24, respectively, except that rather than reciting the presence of a debonding agent in an amount from about 21 to about 50% by weight based on the total weight of the composition, Claims 32 and 33 recite the presence of a vegetable oil and soybean oil, respectively, in an amount from about 17 to about 50% by weight based on the total weight of the composition. Applicant believes that Claims 32 and 33 are allowable in view of the Examiner's comments in the Advisory Action.

Non-Statutory Double Patenting Rejection

Claims 1-5, 9-13, and 15-22 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 2, 3, 9-13, and 15-22 of copending Application No. 09/943,885 in view of U.S. Patent No. 5,700,522, to Nonweiler et al. Applicant respectfully requests that the Examiner withdraw the provisional rejection in the present application and, as necessary, make the double patenting rejection in application No. 09/943,885 (i.e., make the double patenting rejection in the '885 application

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{LLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

based on the allowed claims in the present application, application No. 09/829,508), in the event that the rejection remains appropriate and applicant continues prosecution of the '885 application.

The Rejection of Claims 1-6, 9-13, 15-22, and 24-28 Under 35 U.S.C. § 103(a)

Claims 1-6, 9-13, 15-22, and 24-28 stand rejected under 35 U.S.C. § 103(a). Claims 1-6, 9-13, and 15-22 stand rejected as unpatentable over U.S. Patent No. 3,894,976, to Kang et al., in view of U.S. Patent No. 3,951,899, to Seiner, and U.S. Patent No. 2,374,678, to Gruenwald. Claims 1-5, 9, and 15-21 stand rejected as unpatentable over U.S. Patent No. 3,959,224, to Coleman et al., in view of Gruenwald. Claims 10-13 stand rejected as unpatentable over Coleman et al. in view of Gruenwald as applied to Claims 1-5, 9, and 15-21, and further in view of U.S. Patent No. 6,013,721, to Schall et al. Claims 24 and 26-28 stand rejected as unpatentable over Kang et al. in view of U.S. Patent No. 4,045,393, to Krevanas et al., and Gruenwald. Claim 25 stands rejected as unpatentable over Kang et al. in view of Krevanas et al. and Gruenwald as applied to Claims 24 and 26-28, and further in view of Nonweiler et al. Claims 24 and 26-28 stand rejected as unpatentable over Coleman et al. in view of Gruenwald. Claim 25 stands rejected as unpatentable over Coleman et al. in view of Gruenwald as applied to Claims 24 and 26-28, and further in view of Nonweiler et al.

Claims 1 and 24 have been amended. Claims 2-6, 9-13, and 15-22 depend from Claim 1 and Claims 25-28 depend from Claim 24.

As amended, Claim 1 recites a water-based paint composition comprising an opacifying agent, a viscosity enhancing agent, an anionic surfactant comprising a salt derived from morpholine and a long-chain carboxylic acid, a polymeric binding agent, and a debonding agent active on metal surfaces, wherein the debonding agent is present in an amount from about 21 to about 50% by weight based on the total weight of the composition, and wherein the debonding agent comprises a vegetable oil.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

As amended, Claim 24 recites a water-based paint composition comprising an opacifying agent including titanium dioxide, a viscosity enhancing agent including hydroxy ethylcellulose, an anionic surfactant comprising a salt derived from morpholine and a long-chain carboxylic acid, a polymeric binding agent including acrylic latex, and a debonding agent active on metal surfaces, wherein the debonding agent is present in an amount from about 21 to about 50% by weight based on the total weight of the composition, and wherein the debonding agent comprises soybean oil.

The amendments to Claims 1 and 24 are based on the weight percent of soybean oil disclosed in the Example in the specification

The claimed invention is not obvious in view of the teaching of the cited references. Three basis criteria are necessary to establish a prima facie case of obviousness: the prior art references must teach or suggest all of the claim limitations; there must be some suggestion or motivation, either in the references or in the knowledge of one skilled in the art, to modify the reference or to combine reference teachings; and, there must be a reasonable expectation of success. Because the cited references do not describe the invention as now claimed, and further fail to teach, suggest, provide motivation to make, or otherwise render obvious the claimed invention, applicant respectfully requests that the rejections be withdrawn.

First Rejection Under 35 U.S.C. § 103(a)

Claims 1-6, 9-13, and 15-22 stand rejected as unpatentable over Kang et al. in view of Seiner and Gruenwald. The Office Action states that in light of this combination, it would have been obvious to one of ordinary skill in the art to use the surfactant of Gruenwald in the paint of Kang et al. in order to produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention. Applicant respectfully disagrees for the following reasons.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

The Office Action states that Kang et al. teach a water-based paint comprising binder that is polyacrylate emulsion, titanium dioxide, anionic/nonionic surfactant, hydroxyethylcellulose, antifoaming agent, biocide, fumed silica, and oil, such as linseed oil, that comprises 5-65% of the binder. The Office Action further states that Kang et al. describe one type of acrylic emulsion suitable for use in the paint known under the tradename Rhoplex AC-61, which is well-known as found in the Seiner reference, as an emulsion of methylmethacrylate/butyl acrylate copolymer. The Office Action states that Gruenwald teaches a surfactant that is derived from morpholine and a long-chain, i.e., C₁₂-C₃₆, carboxylic acid, wherein the motivation for using such surfactant is that it is inexpensive, imparts enhanced surface-active properties, and produces better pigment dispersions.

Claims 2-6, 9-13, and 15-22 depend from Claim 1. As amended, Claim 1 recites a composition that includes, among other components, a surfactant and a debonding agent in an amount from about 21 to 50 percent by weight based on the total weight of the composition. The cited references fail to teach or suggest a composition including a debonding agent in the recited amount.

Furthermore, there is no motivation to combine the teaching of the Kang reference with the teaching of the Gruenwald reference. The advantage of the composition taught by the Kang reference is that it does not use a surfactant for dispersion. The Kang reference teaches away from using a surfactant, instead using Heteropolysaccharide-7 to disperse the pigment. See Kang et al., Col. 7, line 65, to Col. 8, line 6. Adding the surfactant taught by the Gruenwald reference to the paint in the Kang reference would give the paint surface "an unsightly film" (Kang et al., Col. 8, line 5) and render the composition of the Kang reference inoperable for its purpose.

Because the Kang reference teaches that the dispersing characteristics of the paint containing Heteropolysaccharide-7 permits paint formulation using substantially less or no

surfactant, there can be no motivation to add a surfactant, as taught by the Gruenwald reference, to the paint composition described by the Kang reference. Withdrawal of this grounds for rejection is respectfully requested.

Second Rejection Under 35 U.S.C. § 103(a)

Claims 1-5, 9, and 15-21 stand rejected as unpatentable over Coleman et al. in view of Gruenwald. The Office Action states that it would have been obvious to one of ordinary skill in the art to use the surfactant taught by Gruenwald in the paint taught by Coleman et al. in order to produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention. Applicant respectfully disagrees for the following reasons.

The Office Action states that Coleman et al. teach a water-based paint comprising latex obtained from alkyl (meth)acrylates, titanium dioxide, 0.1% to 1% surfactant, thickening agent such as hydroxyethylcellulose, dispersant, plasticizer, preservative, vegetable oil such as soybean oil, and defoamer. The Office Action further states that Coleman et al. teach the use of 9% vegetable oil (soybean oil), as calculated from Paint A in Table I.

Claims 2-5, 9, and 15-21 depend from Claim 1. As amended, Claim 1 recites a composition that includes from about 21 to about 50% by weight of vegetable oil as a debonding agent. Neither the Coleman or Gruenwald references teach or suggest a composition that includes about 21 to about 50% by weight vegetable oil as now claimed. Withdrawal of this grounds for rejection is respectfully requested.

Third Rejection Under 35 U.S.C. § 103(a)

Claims 10-13 stand rejected as unpatentable over Coleman et al. in view of Gruenwald as applied to Claims 1-5, 9, and 15-21, and further in view of Schall et al. The Office Action states that in light of this combination, it would have been obvious to one of ordinary skill in the art to use the specific binder disclosed by Schall et al. in the paint of Coleman et al. in order to produce

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{MLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

paint that effectively adheres to a substrate, and thereby arrive at the claimed invention. Applicant respectfully disagrees for the following reasons.

Claims 10-13 depend from Claim 1, which has been amended. The composition of Claim 1, is neither taught nor suggested by the teachings of the Coleman and Gruenwald references. The deficiencies of the teachings of the Coleman and Gruenwald references noted above are not cured by the teaching of the Schall reference. The cited references, either alone or in combination, fail to teach or suggest a composition that includes a debonding agent active on metal surfaces that is present in an amount from about 21 to about 50% by weight based on the total weight of the composition, and wherein the debonding agent comprises vegetable oil. Withdrawal of this grounds for rejection is respectfully requested.

Fourth Rejection Under 35 U.S.C. § 103(a)

Claims 24 and 26-28 stand rejected as being unpatentable over Kang et al. in view of Krevanas et al. and Gruenwald. The Office Action states that it would have been obvious to one of ordinary skill in the art to use soybean oil and surfactant derived from morpholine and long chain, i.e., C₁₂-C₃₆, carboxylic acid in the paint of Kang et al. in order to produce a paint which will not rust metal substrates and possesses superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention. Applicant respectfully disagrees for the following reasons.

The Office Action states that the Krevanas et al. reference teaches the use of soybean oil in order to prevent paint from rusting metal substrate on which it is coated. The Office Action further states that Krevanas et al. teaches the equivalence and interchangeability of linseed oil as disclosed by Kang et al. with soybean oil.

Claims 26-28 depend from Claim 24. As amended, Claim 24 recites a composition that includes, among other components, a surfactant and a debonding agent in an amount from about

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

21 to 50 percent by weight based on the total weight of the composition. The deficiencies of the teachings of the Kang and Gruenwald references noted above is not cured by the teaching of the Krevanas reference. The cited references, either alone or in combination, fail to teach, suggest, provide any motivation to make, or otherwise render obvious the invention as now claimed. Withdrawal of this grounds for rejection is respectfully requested.

Fifth Rejection Under 35 U.S.C. § 103(a)

Claim 25 stands rejected as unpatentable over Kang et al. in view of Krevanas et al. and Gruenwald as applied to Claims 24 and 26-28 above, and further in view of Nonweiler et al. The Office Action states that in light of the motivation for using a coalescing agent as disclosed by Nonweiler et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such coalescing agent in the paint of Kang et al. in order to produce a paint which forms a continuous film, and thereby arrive at the claimed invention. Applicant respectfully disagrees for the following reasons.

Claim 25 depends from Claim 24, which has been amended.

The deficiencies of the teachings of the Kang, Gruenwald, and Krevanas references noted above are not cured by the teaching of the Nonweiler reference. The cited references, either alone or in any combination, fail to teach, suggest, provide any motivation to make, or otherwise render obvious the invention as now claimed. Withdrawal of this grounds for rejection is respectfully requested.

Sixth Rejection Under 35 U.S.C. § 103(a)

Claims 24 and 26-28 stand rejected as unpatentable over Coleman et al. in view of Gruenwald. The Office Action states that it would have been obvious to one of ordinary skill in the art to use the surfactant taught in Gruenwald in the paint of Coleman et al. in order to

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention. Applicant respectfully disagrees for the following reasons.

Claims 26-28 depend from Claim 24, which has been amended. As amended, Claim 24 recites a composition that includes from about 21 to about 50% by weight soybean oil as a debonding agent. The cited references, either alone or in combination, fail to teach or suggest a composition that includes about 21 to about 50% by weight soybean oil as a debonding agent, as now claimed. Withdrawal of this grounds for rejection is respectfully requested.

Seventh Rejection Under 35 U.S.C. § 103(a)

Claim 25 stands rejected as unpatentable over Coleman et al. in view of Gruenwald as applied to Claims 24 and 26-28 above, and further in view of Nonweiler et al. The Office Action states that in light of the motivation for using a coalescing agent disclosed by Nonweiler et al. as described above, it would have been obvious to one of ordinary skill in the art to use such coalescing agent in the paint of Coleman et al. in order to produce a paint which forms a continuous film, and thereby arrive at the claimed invention. Applicant respectfully disagrees for the following reasons.

Claim 25 depends from Claim 24, which has been amended. The deficiencies of the teachings of the Coleman and Gruenwald references noted above are not cured by the teaching of the Nonweiler reference. The cited references, either alone or in combination, fail to teach or suggest a composition that includes a debonding agent active on metal surfaces present in an amount from about 21 to about 50% by weight based on the total weight of the composition, and wherein the debonding agent comprises soybean oil. Withdrawal of this grounds for rejection is respectfully requested.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

New Claims 32 and 33

Claims 32 and 33 have been added. Claim 32 corresponds to Claim 1 except that, instead of reciting the presence of a debonding agent in an amount from about 21 to 50% by weight based on the total weight of the composition, Claim 32 recites that the composition includes vegetable oil in an amount from about 17 to about 50% by weight based on the total weight of the composition. Similarly, Claim 33 corresponds to Claim 24 except that, instead of reciting the presence of a debonding agent in an amount from about 21 to 50% by weight based on the total weight of the composition, Claim 33 recites that the composition includes soybean oil in an amount from about 17 to about 50% by weight based on the total weight of the composition.

Conclusion

In view of the above amendments and foregoing remarks, applicant believes that Claims 1-6, 9-13, 15-22, 24-28, 32, and 33 are in condition for allowance. If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone applicant's attorney at 206.695.1755.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



George E. Renzoni, Ph.D.
Registration No. 37,919
Direct Dial No. 206.695.1755

GER/ECP:tm/ctg

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100